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FACSIMILE TRANSMISSION

April 23, 2002

To: Examiner M. Alvo
Group Art Unit 1731
United States Patent and Trademark Office

Re: United States Patent Application No. 08/907,687
Title: Method of Pretreating Lignocellulose Fiber-Containing
Material for the Pulp Making Process
Inventor: Marc J. Sabourin
Our Ref.: ANDR/346/US

FAX: (703) 872-9311

FROM: L. JAMES RISTAS, ESQ.

MESSAGE: Please find attached the Supplementary Response to Final Action.

NUMBER OF PAGES BEING TRANSMITTED 3 page(s) including cover sheet.

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CONFIRMATION COPY TO FOLLOW: ☐ Yes ☒ No

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

#27/BM
5-9-02

In re patent application of: Marc SABOURIN

Application No.: 08/907,687

Examiner: M. Alvo

Filing Date: August 8, 1997

Group Art Unit: 1731

For: **Method of Pretreating Lignocellulose Fiber Containing
Material for the Pulp Making Process**

**Commissioner for Patents
Washington, DC 20231**

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Sir:

Supplemental Response to Final Action

Applicant hereby supplements the Response after final mailed April 11, 2002, by drawing the examiner's attention to the recently decided *In re Glaug*, Fed. Cir., No. 00-1571 (March 15, 2002) according to which the CAFC held that data in a patent specification should have been considered as evidence of non-obviousness because it was offered as illustrative of an advantageous property of the claimed invention.

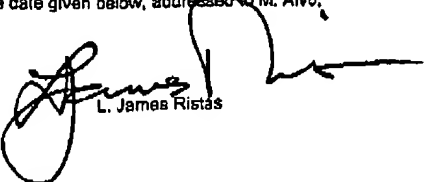
In the subject application, Example 1 of Table A was offered to show that the pretreatment of wood chip material at elevated saturated steam conditions, produces an effect on the chips such that when preheated and refined according to the same reference conditions, the resulting pulp according to the invention is superior (or in the alternative, significant energy savings are achieved when the material is refined to the same pulp quality).

Although the CAFC decision cited above did not specifically address data

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Date: April 23, 2002


L. James Ristas

provided in a Rule 132 Declaration, such Declaration is now of record. The Declaration discusses technical papers presented to a sophisticated audience in the relevant field and provides further data supporting applicant's contention that the invention as claimed was not disclosed, taught or suggested by the references of record, nor in any other way a mere obvious increment to the state of the art. Rather, the full scale plant data show a very significant improvement in energy consumption to achieve similar pulp quality.

The technical and patent literature is replete with explanations on the major objective of reducing energy cost in mechanical refining. Many researchers in this field are devoting considerable resources towards this end. Applicant's significant improvement in energy consumption, when viewed against this back drop, provides strong secondary evidence supporting patentability.

As the CAFC noted in the cited decision, "While the measurement of a physical property may not of itself impart patentability to otherwise unpatentable claims, when the measured property serves to point up the distinction from the prior art, or advantages over the prior art, that property is relevant to patentability and its numerical parameters can not only add to precision to the claims but also may be considered, along with all of the evidence, in determination of patentability".

Respectfully submitted,
Marc SABOURIN



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